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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,733	12/01/2006	Gary Fenton	DEP5043USPCT	2488

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EXAMINER	
LAWSON, MATTHEW JAMES	
ART UNIT	PAPER NUMBER
3775	

NOTIFICATION DATE	DELIVERY MODE
10/29/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/587,733	FENTON ET AL.	
	Examiner	Art Unit	
	MATTHEW LAWSON	3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/9/2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 9th, 2010 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer (US 5,171,313) in view of Keller (US 5,928,287).

Regarding claims 1 3-6, 8-10, 12, 15, and 18, Salyer discloses an instrument for positioning a cup component of an orthopedic joint prosthesis, the cup component having a mouth (figure 1) and an inner surface with a circumferential groove (22, figure figures 5a-5c) the instrument comprising a shaft (16, figure 2) having a shaft axis (14, figure 2) and a distal end a housing (see figure below) attached to the distal end of the shaft, the housing extending from the shaft transversely relative to the shaft axis (figures

2-3), the housing comprising a base plate (see figure below), and a flange portion (26, figure 2) carried on the shaft, the flange portion being configured to be movable relative to the base plate in a direction transverse to the shaft axis between an in-use position (figure 2) where the flange portion received in the groove of the cup component (column 3, lines 58-67), and a retracted position where the flange portion is moved toward the shaft axis so as to allow the cup component to be released from the instrument (figure 3, column 3, lines 58-67), and wherein the flange portion is biased towards the in-use position (column 3, lines 3-14 and 58-67, and claims 6 and 11), wherein the flange portion is biased towards the in-use potion by a spring element (42, figures 2-3) and the housing further comprises an opposing plate (see figure below), and the flange portion is silidably disposed between the base plate and the opposing plate (column 3, lines 58-67). The base plate being planar and has a plate surface and the flange portion is planar and has a flange surface of the base plate and flange surface of the flange portion are configured to slide relative to one another in the direction transverse to the shaft axis (figures 2-3), wherein the spring element is disposed between the flange portion and the axis of the shaft, and is compressed elastically by the flange portion when the flange portion is moved form the in-use position towards the retracted position (figures 2-3); wherein the base plate has a surface (20, figures 2-3) configured to engage the cup component to apply force to the cup component when the flange portion is in the in-use position (column 5, lines 16-24), and the base plate has at least one base plate hole (see figure below) and the flange portion (26, figures 2-3) has at least one flange hole (52, figures 2-3), and further comprising a collar having at least one pin

(54, figures 2-3) extending distally from the collar, the collar slidably connected to the shaft so as to slide between a first position where the flange is in the in-use position (figure 2), and a second position where the pins are at least partially disposed within the at least one base plate hole and the at least one flange hole (figures 2-3, column 3, lines 58-67), wherein the flange and base plate are configured such that when the collar is in the first position, the at least one base plate hole and the at least one flange hole are not aligned (figure 2).

Salyer does not expressly disclose the use of at least two flange portions carried on the shaft, each being configured to move relative to the base plate in a direction transverse to the shaft axis and being biased to an in-use position by a spring element disposed between the at least two flange portions, the spring biasing the at least two spring portions into the in-use position. Salyer does however disclose that at least one pin "flange portion" being movable in relation to said body in response to movement of the plunger (see abstract).

Further, Keller discloses the use of at least two flange portions (12, figures 1-4) carried on the shaft (3/16, figure 1), each being configured to move relative to the base plate (5, figures 1-3) in a direction transverse to the shaft axis (10, figure 1, column 4, lines 3-56), a spring element (13, figures 1-2) biasing the at least two flange portions into the in-use position (column 4, lines 3-19) to permit balanced locking forces (column 2, lines 59-61).

Accordingly it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have the at least one pin “flanged portion” movable from a biased in-use position for at least two flanged portions as taught by Keller to permit balanced locking forces on the acetabular cup.

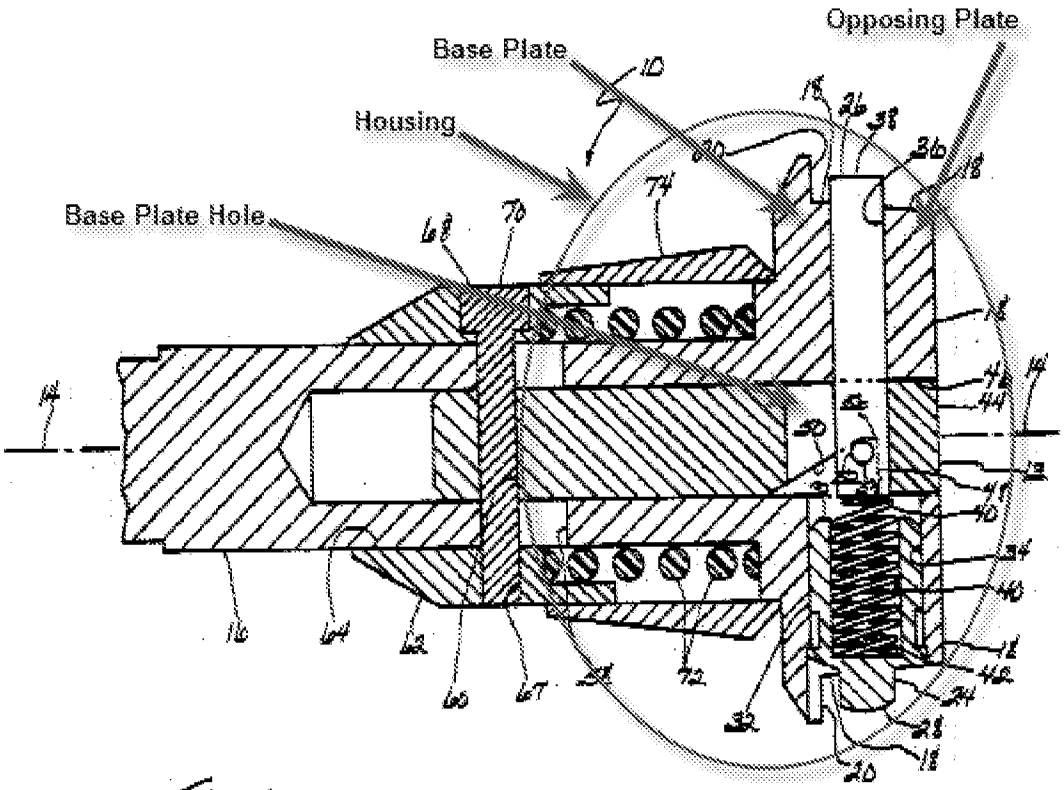

FIG. 2

Regarding claim 5, Salyer discloses the claimed invention except for the spring element being made from a non-metallic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the spring of Salyer to be made of a non-metallic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claims 8-9, Salyer in view of Keller disclose the claimed invention except for the flange being made from a non-deformable material, specifically a metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the flange of Salyer to be made of a non-deformable material, specifically a metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Salyer in view of Keller having a three radially space apart flange portions instead of two, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Claims 11, and 13-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer (US 5,171,313) in view of Keller (US 5,928,287) in further view of Cohen (US 5,486,181).

Regarding claim 11 Salyer discloses the claimed invention except for the flange portion having a chamfered edge that is configured to contact the inner surface of the

cup component when the flange portion is in the in-use position.

Cohen discloses a flange portion (figures 4a-4c) having a chamfered edge (92, figure 4b, 90, figures 4a-4b) to contact the inner surface of the cup component when the flange portion is in the in-use position to increase the surface area to better lock the instrument component to the cup component (column 7, lines 9-14, 29-39).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the device of Salyer in view of Keller to have a chamfered edge on the flange portion as taught by Cohen to better lock the flange to the cup component due to the increase in contacting surface area produced by the chamfered edge.

Regarding claim 13, Salyer in view of Keller disclose the claimed invention except for the instrument having a soft cap positioned between the flange and the end of the shaft and which at least partially surrounds the end of the shaft.

Cohen et al. disclose an instrument for positioning a cup component of an orthopedic joint prosthesis, having a soft cap (60, figures 7a-7b) which is positioned between the flange and the end of the shaft and is at least partially surrounded by the end of the shaft to create an interference fit between the cup (column 5, lines 22-29).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the device of Petersen to have a soft cap to create an interference fit between the cup.

Regarding claim 14, Salyer in view of Keller disclose that the instrument may connect to a reamer head or an other tool (column 3, lines 3-6). Cohen discloses the attachment of a cup component of a joint prosthesis connected to the instrument.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the reamer of Salyer in view of Keller for an "other tool" *i.e.* the cup component of a joint prosthesis as taught by Cohen.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer (US 5,171,313) in view of Keller (US 5,928,287) in view of Techiera et al. (US 2005/0131420)

Salyer in view of Keller disclose the claimed invention except that spring is a coil spring instead of an O-ring. Techiera et al. shows that an o-ring is an equivalent structure known in the art (¶53). Therefore, because these two springs were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the coil spring of Salyer in view of Keller for the o-ring of Techiera et al

Claims 16-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Salyer (US 5,171,313) in view of Keller (US 5,928,287) in view of Weigan et al. (US 4,023,572).

Salyer in view of Keller disclose the claimed invention except for the flange

portion having an upstand that is configured to compress the spring.

Weigan et al. disclose the use of an upstand 326, figure 24) on the flange portion (327, figure 24) which is configured to compress the spring (column 12, lines 56-67 and column 13, lines 1-32) to better contain the spring during movement of the collar (column 12, lines 56-67 and column 13, lines 1-32).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the flange of Salyer in view of Keller to include an upstand as taught by Weigan et al. to better contain the spring during movement of the collar.

Response to Arguments

Applicant's arguments with respect to claims 1, and 3-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art Unit 3775